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REMARKS

Applicants hereby add claims 34-40. Accordingly, claims 1, 3-16, 24, 26, and 30-40 are pending in the present application.

Claims 3-4, 6-7, 11-12, 14 and 33 are objected to. Claims 1, 3-16, 24, 30 and 32-33 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent Publication No. 2002/0077979 to Nagata. Claims 26 and 31 stand rejected under 35 USC 103(a) for obviousness over Nagata.

Applicants respectfully request reconsideration of the rejections.

Referring to the claim objections, and without admitting to the propriety of the objections, Applicants have amended claims 1 and 9. Applicants respectfully submit the claims are definite.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements of the prior art must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants first refer to independent claim 9 as first mentioned in the Office Action. Applicants respectfully submit that the anticipation rejection of claim 9 is improper for the below-mentioned compelling reasons.

More specifically, claim 9 recites the *processing circuitry configured to compare a received party identifier with a stored party identifier of a respective one of the consumables corresponding to the received consumable identifier*. The Office at page 8 of the Action relies upon the teachings of paragraphs 367 and 368 of Nagata as allegedly disclosing the above-recited limitations. However, as is clear from Fig. 34, Nagata first locates the spare cartridge table containing the contract signer ID at step 367 and then *thereafter* at step S368 checks the retrieved table for the status of the cartridge identifier by the unique data of the cartridge received in step S30. Accordingly, in the process of Fig. 34, the processing section 122 has no information regarding the consumable until after the contract signer ID is used to locate the retrieved table. There is no evidence that the section 122 again compares the contract signer IDs after the table is retrieved and such would be non-sensical inasmuch as the

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table for the signer has already been retrieved. When section 122 of Nagata searches and compares the contract signer ID it is not disclosed as comparing the signer ID with the stored party identifier of the respective consumable corresponding to the received consumable identifier. Accordingly, Nagata fails to disclose or suggest the *processing circuitry configured to compare the received party identifier with the stored party identifier of a respective one of the consumables corresponding to the received consumable identifier* as claimed. Limitations of claim 9 are not disclosed nor suggested by the prior art and claim 9 is allowable for at least this reason.

Further referring to claim 9, the processing circuitry is configured to control *outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable* and wherein the communication indicates the failure of the received party identifier to match the stored party identifier of the respective consumable. At pages 8-9 of the Action, the Office recites step S45 and the teachings in paragraph 387. However, as is clear from Fig. 34, at step S45 and as described at paragraphs 369, and 385-387, the on-screen warning is displayed responsive to the result of step S33 being "no" to whether the current status is "new(spare)" and the negative response to a condition of whether the current status is "in use" of step S43. Fig. 34 fails to disclose or suggest the above-recited limitations including *outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable*.

Furthermore, the Office at page 9 further relies upon the teachings of paragraphs 360-362 of Nagata. As is clear from paragraph 361, the notification steps are executed if the section 122 detects the same ID number as that already registered is "used." These teachings are void of disclosing or suggesting the claimed *outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable*.

The Office also relies upon the teachings of Fig. 83, step S56. However, the teachings in Fig. 83 relate to operations of the image forming apparatus 2 as provided at paragraph 1236. Applicants have failed to uncover any teachings of Fig. 83 regarding the image forming apparatus of the claimed *outputting of a communication responsive to the received party identifier not matching the stored party identifier of the respective consumable*.

Finally, claim 9 recites that the communication indicates the *failure of the*

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received party identifier to match the stored party identifier of the respective consumable. Paragraph 387 merely discusses display of an on-screen warning and fails to teach or suggest that *the warning indicates the failure of the received party identifier to match the stored party identifier of the respective consumable as specifically claimed.* Also, the dispatching of the service person at paragraphs 360-362 merely states that an on-screen prompt message and email notification notify of service technician of the situation which fails to teach or suggest *the warning indicates the failure of the received party identifier to match the stored party identifier of the respective consumable as specifically claimed.* Finally, the teachings of Fig. 83 refer to a print permission message which fails to teach or suggest *the warning indicates the failure of the received party identifier to match the stored party identifier of the respective consumable as specifically claimed.*

Applicants respectfully submit the limitations of claim 9 are not disclosed nor suggested by the prior art and claim 9 is allowable for at least this reason.

The claims which depend from independent claim 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 12, it is stated that the processing circuitry is configured to *forward the communication comprising a warning message to an image forming device* coupled with the consumable to be verified responsive to the comparison. The Office at page 10 in support of the rejection recites teachings in paragraphs 360-362. These teachings disclose sending a service person to the contract signer 1 which fails to disclose or suggest the claimed processing circuitry configured to forward the communication comprising the warning message to the image forming device as claimed. In addition, the teachings in paragraphs 1250-1252 generically disclose that a message may be displayed without teaching that the message was forwarded to the image forming device by the processing circuitry of the claimed consumable monitoring system. Furthermore, paragraphs 1250-1252 are void of teaching that the message is displayed by the image forming device. Applicants respectfully submit that claim 12 is allowable for at least these reasons.

Referring to dependent claim 13, the processing circuitry is configured to forward *date and time information regarding reception of a received consumable identifier and*

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the received party identifier. The Office relies upon Figs. 9-12 which illustrate date information but not time. The 102 rejection is improper for at least this reason. In addition, Figs. 9-12 teach dates of replacement, dates of expiry, dates of delivery, and dates of installation which fail to teach or suggest the claimed *date and time information regarding reception of the received consumable identifier and received party identifier*. Claim 13 is allowable for at least this reason.

Referring to claim 32, the *communication indicates use of the consumable by an unauthorized party*. The Office relies upon the teachings in paragraph 387. However, the generic on-screen warning of paragraph 387 fails to teach or suggest the claimed communication indicates use of the consumable by an unauthorized party. The message of paragraph 1252 relates to a message stating "The toner cartridge installed is not proper. Please replace it with a proper toner cartridge" which fails to teach or suggest the claimed communication *indicating use of the consumable by an unauthorized party*. Claim 32 is allowable for at least this reason.

Referring to independent claim 1, the Office relies upon the teachings of Nagata as applied against claim 9 in support of the rejection of claim 1. At pages 8-9 of the Action, the Office recites step S45 and the teachings in paragraph 387. However, as is clear from Fig. 34, at step S45 and as described at paragraphs 369, and 385-387, the on-screen warning is displayed responsive to the result of step S33 being "no" to whether the current status is "new(spare)" and the negative response to a condition of whether the current status is "in use" of step S43. Fig. 34 fails to disclose or suggest *outputting a message responsive to the comparings (of the consumable identifiers and party identifiers recited in claim 1) to indicate use of the consumable by an unauthorized party* as defined in claim 1. Furthermore, referring to paragraph 361, the notification steps are executed if the section 122 detects the same ID number as that already registered is "used." These teachings are void of disclosing or suggesting the claimed *outputting a message responsive to the claimed comparings to indicate use of the consumable by an unauthorized party* as defined in claim 1. Applicants have failed to uncover any teachings of Fig. 83 of the claimed *outputting a message responsive to the comparings to indicate use of the consumable by an unauthorized party*.

Applicants respectfully submit that limitations of claim 1 are not disclosed nor suggested by the prior art and the 102 rejection of claim 1 is improper for at least this reason.

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The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the 103 rejections, the Office has failed to provide requisite motivation to modify Nagata and the Office has failed to establish a *prima facie* 103 rejection for at least this reason.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness*. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §2142 (8th ed., rev. 3).

Applicants respectfully submit the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective*

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*belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed. The Court further stated that the determination of patentability must be based on evidence. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references. The statement on page 15 of the Action that it would have been obvious to modify Nagata to obtain the claimed invention is insufficient and the 103 rejections are improper.*

Applicants hereby add new claims 34-42 which are supported at least by Figs. 2, 3, 5 and 6 and the associated specification teachings of the originally filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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